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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 3621

Taizo SHIRAI, et al.

SERIAL NO: 10/680,381

EXAMINER: KAMAL, SHAHID

FILED: October 8, 2003

FOR: INFORMATION PROCESSING DEVICE, CONTENTS DISTRIBUTION
SERVER, LICENSE SERVER, AND METHOD AND COMPUTER
PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.


This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-24 are pending in this case.

The outstanding Office Action rejected Claims 1-24 under 35 U.S.C. § 103(a) as unpatentable over Stefik, et al. (U.S. Patent No. 6,957,193, herein “Stefik”) in view of Spagna, et al. (U.S. Pub. No. 2006/0089912, herein “Spagna”).

Applicants respectfully traverse the rejection of the pending claims. Specifically, as set out at item 4 of the guide for the Pre-Appeal Brief Conference Pilot Program, Applicants assert that a *prima facie* rejection is not established in this case for at least two reasons.

First, the asserted combination of references cannot establish a *prima facie* case of obviousness. Even in combination, the references fail to teach or suggest at least the claimed license storage device, because neither of the references teaches or suggests the claimed license storage device.

Applicants’ response, filed on January 12, 2009, clearly sets out, at pages 11-12, that Spagna fails to cure the deficiencies of Stefik that are conceded to by the outstanding Office Action.

Second, the outstanding Office Action fails to set out a modification of one reference with the other reference, as required by MPEP § 706.02(V), and fails to clarify a motivation for the asserted modification, as required by MPEP § 2143.01.

At page 3, the outstanding Office Action states:

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Stefik for a repository with security class and method for use thereof with the features of Spagna for a system and method of updating usage conditions in lieu of download digital rights management protected content in order provide these goals. a need exists for digital content providers to use an electronic distribution model to make digital content available to a wide range of users and businesses while ensuring protection and metering of digital assets.

Applicants respectfully submit that no specific modification nor motivation for a modification of Stefik with Spagna can be discerned from the above statement.

Further, the Examiner has never responded to the substance of Applicants' arguments directed to the rejection of the pending claims under 35 U.S.C. § 103(a), in derogation of MPEP § 707.07(f). With regard to Applicants' arguments regarding the asserted combination, which was first asserted in the outstanding Office Action, the Advisory Action dated February 6, 2009 states that "Applicants' arguments merely rehash issues addressed in the Final Rejection." However, the outstanding Office Action (Final Rejection), could not possibly address Applicants' arguments to the outstanding Office Action.